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10/541,949

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Magne Solbakken

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GE HEALTHCARE, INC.

IP DEPARTMENT

101 CARNEGIE CENTER

PRINCETON, NJ 08540-6231

EXAMINER

SCHLIENTZ, LEAH H

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

08/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                         |  |
|------------------------------|--------------------------------------|-----------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/541,949 | <b>Applicant(s)</b><br>SOLBAKKEN ET AL. |  |
|                              | <b>Examiner</b><br>Leah Schlientz    | <b>Art Unit</b><br>1618                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgement of Receipt***

Applicant's Response, filed 2/21/2008, in reply to the Office Action mailed 8/24/2007, is acknowledged and has been entered. Claim 1 has been amended. Claims 2, 3, 5, 6 and 8 have been cancelled. Claim 11 is newly added. Claims 1, 4, 7 and 9 – 11 are pending and are examined herein on the merits for patentability.

### ***Response to Arguments***

Applicant's arguments, see pages 5 – 6 of the Response, with respect to the rejection of claims 1 – 10 on the ground of non-statutory obviousness-type double patenting over the claims of US 6,264,914; 6,921,525 and 7,182,934 have been fully considered. The rejections have been WITHDRAWN as being overcome by amendment.

Applicant's arguments, see page 6 of the Response, with respect to the rejection of claims 1 – 10 on the ground of provisional non-statutory obviousness-type double patenting over the claims of US 10/559,880, have been fully considered, but are not found persuasive for reasons set forth hereinbelow.

Applicant's arguments, see page 6 of the Response, with respect to the rejection of claim 8 under 35 U.S.C. 101, have been fully considered. The rejection has been WITHDRAWN in view of cancellation of the claim.

Applicant's arguments, see page 7 of the Response, with respect to the rejection of claim 8 under 35 U.S.C. 112, first paragraph, have been fully considered. The rejection has been WITHDRAWN in view of cancellation of the claim.

Applicant's arguments, see page 7 of the Response, with respect to the rejection of claims 1 – 3 and 10 under 35 U.S.C. 112, second paragraph, have been fully considered. The rejection has been WITHDRAWN as being overcome by amendment.

Applicant's arguments, see pages 7 – 8 of the Response, with respect to the rejection of claims 1, 2 and 5 – 10 under 35 U.S.C. 102(b) as being anticipated by Klaveness *et al.* (US 6,264,914), have been fully considered. The rejection has been WITHDRAWN as being overcome by amendment.

Applicant's arguments, see pages 8 – 9 of the Response, with respect to the rejection of claims 1 – 10 under 35 U.S.C. 103(a) as being unpatentable over Klaveness *et al.* (US 6,264,914) in view of Cuthbertson *et al.* (WO 03/006491), have been fully considered, but are not found persuasive for reasons set forth hereinbelow.

### ***Double Patenting***

Claims 1, 4, 7 and 9 – 10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/559,880 for reasons set forth in the Office Action mailed 8/24/2008.

Applicant argues on page 6 of the Response that the present application was filed prior to Application 10/559,880 and that the provisional double patenting rejection should therefore be withdrawn.

This is found non-persuasive. The claims are overlapping in scope as set forth in the Office Action mailed 8/24/2008 and no terminal disclaimer has been filed in the instant application or the '880 application, thus the rejection is maintained.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4, 7 and 9 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klaveness *et al.* (US 6,264,914) in view of Cuthbertson *et al.* (WO 03/006491), for reasons set forth in the Office Action mailed 8/24/2007.

Applicant argues on pages 8 – 9 of the Response that the subject matter as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art. The invention of Cuthbertson was first made publicly available on January 23, 2003 by the publication of WO 03/006491 for Amersham Health AS with the inventors Cuthbertson, Indrevoll and Solbakken. Applicant contends

that the present application takes priority from January 9, 2003 Norwegian Patent Application 20030115 of Amersham Health AS with inventors Solbakken, Engell, Wadsworth and Archer. Applicant argues that Cuthbertson is not prior art since Cuthbertson and the present application are not described in a published application for a patent by another filed in the U.S. before the invention by Applicants, and that Cuthbertson is not available as obviousness prior art under 35 USC 103(a) since the subject matter and the claimed inventions were owned by the same persons.

This is not found persuasive. The Cuthbertson publication is entitled to the filing date of PCT/NO2002/000250, or July 8, 2002. Applicant's attention is directed to the conditions for loss of right to patent under 35 U.S.C. 102(e):

**35 USC § 102**

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

In the instant case, the Cuthbertson document meets the conditions of an application for patent by another filed in the U.S. before the invention by Applicant, because it meets the conditions defined in section 351(a) as the application designates the U.S. and was published in English. The Cuthbertson document is considered to be “by another” because it has a different inventive entity than that of the instant application (i.e. additional inventors Cuthbertson and Indrevoll). Accordingly, the Cuthbertson document is available as prior art under 35 U.S.C. 102(e).

However, Applicant is respectfully directed to **MPEP 706.02(I)(3)**. The Cuthbertson reference could potentially be disqualified under 35 U.S.C. 103(c), if applicable. "Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s). In order to overcome a rejection under 35 U.S.C. 103(a) based upon a reference which qualifies as prior art under only one or more of 35 U.S.C. 102(e), (f), or (g), via the CREATE Act, the applicant must comply with the statute and the rules of practice in effect."

In the instant case, the Response filed 2/21/2008 speaks only to common ownership at the time of filing of the WO 03/006491 and Norwegian 20030115 Applications. Since no statement was provided under 35 U.S.C. 103(c) regarding the ownership status of the subject matter in the WO 03/006491 at the time the invention was made, the Cuthbertson document cannot be withdrawn at this time and the rejection is maintained.

### ***New Grounds for Rejection***

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klaveness *et al.* (US 6,264,914) in view of Cuthbertson *et al.* (WO 03/006491).

The rejection over claims 1, 4, 7 and 9 – 10 is applied as set forth in the Office Action mailed 8/24/2007. With regard to newly added claim 11, it would have been further obvious to include <sup>99m</sup>Tc, <sup>111</sup>In, etc. as the radionuclide because Klaveness teaches said ions to be preferred (column 23, lines 60+).

### ***Specification***

The disclosure is objected to because of the following informalities: the application includes a drawing, but there is no BRIEF DESCRIPTION OF THE DRAWINGS section included in the specification. Appropriate correction is required.

### ***Conclusion***

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



Art Unit: 1618

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is 571-272-9928. The examiner can normally be reached on Monday - Friday 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

LHS